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BASF AKTIENGESELLSCHAFT
CARL-BOSCH STRASSE 38, 67056
LUDWIGSHAFEN
LUDWIGSHAFEN 69056 DE GERMANY

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OFFICE OF PETITIONS

In re Application of :
Bruchman et al. :
Application No. 09/811987 :
Filing or 371(c) Date: 03/19/2001 : **ON PETITION**
Attorney Docket Number: 12075 :

This is a decision on the Petition for Revival of Application for patent Abandoned Unavoidably, filed February 23, 2007.

This Petition under 37 CFR 1.137(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **granted**.

Background

The above-identified application became abandoned for failure to timely and properly reply to the final office action mailed May 19, 2005. The final office action indicated that no claims were allowed.

Applicant filed an amendment on July 15, 2005; however, the amendment failed to place the application in condition for allowance. Applicant was so Notified in an Advisory Action mailed August 10, 2005.

Applicant filed a Notice of Appeal on August 18, 2005, and a Brief in Support of the Appeal on October 18, 2005. The Brief was Non-Compliant. Applicant was so notified in a Notice of Non-Compliant Appeal Brief mailed January 24, 2006. Applicant filed an Amended Appeal Brief on February 3, 2006. The Examiner filed an Answer to the Appeal Brief on April 20, 2006.

The Board of Patent Appeals and Interferences ("BOARD") issued a Decision on Appeal on August 22, 2006, affirming the decision of the Examiner.

Applicant filed an Amendment After Appeal (In Accordance with MPEP 1214.07). The Amendment was not entered because prosecution was closed and the Amendment was not suggested in an explicit statement by the Board under 37 CFR 41.50(c).

A Notice of Abandonment was mailed January 12, 2007, indicating as the reason for abandonment the decision of the Board, and that the period for seeking court review had expired and no claims were allowed.

The present petition

Applicant files the present petition and asserts that the application was unavoidably abandoned because, after the decision of the Board, and based upon the prosecution history of the application, Applicant's November 24, 2006 Amendment placed the application in condition for allowance. Applicant avers that after filing the November 24, 2006 Amendment, Applicant was informed that the Amendment introduced issues under 35 U.S.C. 112. Applicant avers that it was unaware of any issues with regards to 35 U.S.C. 112 until after the November 24, 2006 Amendment was filed and, as such, the delay in filing the required reply was unavoidable.

A Grantable Petition Under 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks items (3) as set forth above.

Applicable Law, Rules and MPEP

As to item (1), Applicant asserts that a continuing application has been filed; however, Office records do not indicate that a continuing application has been filed, nor has Applicant provided the application no. of the continuing application.

As to item (3), Applicant must provide a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. In order to determine whether the delay was unavoidable, the courts have adopted a "reasonably prudent person" standard. The courts have provided that:

[t]he word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1787 (Fed. Cir. 1995) (citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)). However, "The question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."¹ Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.²

¹ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

² See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

The statute requires a “showing” by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to “show” that the delay was unavoidable.

Analysis

Applicant here asserts that the application was unavoidably abandoned because the Amendment filed after the Board decision should have placed the application in condition for allowance based upon previous indications from the Examiner and the Board.

Applicant states that the Amendment merely re-wrote claim 3 in independent form including all the limitations of claim 1.

The Examiner disagreed, noting in the Notice of Abandonment that the proposed amendment raised issues of indefiniteness, whereas “previously, dependent claim 3 further limited the requirement of independent claim 1....”

37 CFR 1.135(b) provides that

Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

In this instance, Applicant’s Amendment failed to place the application in condition for allowance. While the failure to file a proper amendment may have been unintentional, it cannot be said to have been unavoidable.

Conclusion

Applicant has failed to demonstrate that the failure an Amendment that placed the application in condition for allowance was unavoidable.

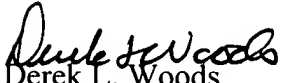
The petition to revive under 37 CFR 1.137(b)

With the instant petition, Applicant has filed a Request for Continued Examination (“RCE”), and a submission in the form of the November 24, 2006 Amendment.

The fee for the petition under 37 CFR 1.137(b) has been charged to deposit account 08-2789 as authorized in the petition.

The application is being referred to Technology Center Art Unit 1711 for processing of the RCE, and for continued examination in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods
Attorney
Office of Petitions